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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,522	12/06/2001	Kan Ebisawa	450100-3580.2	3713

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EXAMINER

JEANTY, ROMAIN

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/007,522

Applicant(s)

EBISAWA, KAN

Examiner

Romain Jeanty

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 53-143, 284-289 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 53-143, 284-289 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Response to Amendment**

1. This Final Office Action is in response to the Amendment filed April 4, 2004. By the Amendment, claims have been amended. Claims 284-289 have been added. Claims 1, 53-143, 284-289 are pending in the application.
2. Applicant's amendment has overcome the 35 U.S.C. 112, first and second paragraph

### **Response to Arguments**

3. Applicant's arguments filed April 5, 2004 with regard to the 35 U.S.C. 103 rejection have been fully considered but they are not persuasive.

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 53-143, and 284, 286, and 288 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al (U.S. Patent No. 5740549) in view of Pirani et al (U.S. Patent No. 5,105,184) as set forth in the last Office Action of paper number 17.

Art Unit: 3623

6. Claims 284, 286, and 288 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al (U.S. Patent No. 5,740,549) in view of Pirani et al (U.S. Patent No. 5,105,184) and further in view of Byrne (Getting the message across). As per claim 285, 287, and 289, the combination of Reilly et al and Pirani does not disclose a traditional advertising location is a billboard. Byrne discloses the idea of an advertising location in a billboard. It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the disclosures of Reilly et al, and Pirani to incorporate an advertising location in a billboard in the same conventional manner as disclosed by Byrne with the motivation to promote brand-recognition.

#### Remarks

7. Applicant has amended the claims to recite ... new .... on a recurring basis and plurality of images .... The examiner notes that Reilly et al teach updating the advertisement in every few seconds and displaying images of the advertisement. Since the advertisement is being updated periodically, it implies that new advertisement is being received. Note col. 8 lines 45-67.

Applicant further argued that Pirani does not disclose a means for receiving new advertising data on a recurring basis. In response, examiner disagrees with argument because Reilly does teach applicant's amended claimed limitations. Note col. 8, lines 45-67. In response to applicant's argument in claim 1 that "different commercial advertisements are displayed in predetermined positions or traditional advertising locations in an executable program.... and these ads are displayed on a billboard or on the

Art Unit: 3623

clothing of a race car driver can be updated..." it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argued that claim 58 depends from amended independent claim 1 and, due to such dependency, it is also believed to be distinguishable from Reilly and Pirani. The examiner notes that since claim 1 is rejected from the applied references Reilly et al and Pirani; therefore, claim 58 is still rejected from the applied references of Reilly et al, Pirani, and Handelman.

Applicant further argued that claim 61 depends from amended independent claim 1 and, due to such dependency, it is also believed to be distinguishable from Reilly and Pirani. The examiner notes that since claim 1 is rejected from the applied references Reilly et al and Pirani; therefore, claim 61 is still rejected from the applied references of Reilly et al, Pirani, and Hornbuckle.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not


Art Unit: 3623

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RJ

June 11, 2004

  
**ROMAIN JEANTY**  
**PRIMARY EXAMINER**  
*Art Unit 3623*